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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/016,079  | 12/12/2001  | Yutaka Hasegawa      | SUZU:002                    | 6932                   |
| 37013 7590 07/18/2007<br>ROSSI, KIMMS & McDOWELL LLP.<br>P.O. BOX 826<br>ASHBURN, VA 20146-0826 |             |                      | EXAMINER<br>BOVEJA, NAMRATA |                        |
|   |             |                      | ART UNIT<br>3622            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>07/18/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/016,079 | <b>Applicant(s)</b><br>HASEGAWA, YUTAKA |  |
|                              | <b>Examiner</b><br>Namrata Boveja    | <b>Art Unit</b><br>3622                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/01/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 04/27/2007.
2. Claims 1-16 are presented for examination.
3. Amendments to claims 1-16 have been entered and considered.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 1-16, are rejected under 103(a) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka) in view of the article titled "Imagine Radio Debuts a New Generation of Customized Radio," from the PR Newswire published on August 24, 1998 on pg. 1 (hereinafter ImgRadio) and further in view of Official Notice.*

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles contribution and distribution of digital contents and presentation of advertising messages to users of the information service via plurality of user terminals *including first and second user terminals* over a computer network (abstract and page 1 paragraphs 12-16), the system comprising: a first database containing advertising messages provided from advertisers (page 1 paragraph 16, page 6

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paragraph 117, page 10 paragraph 181, page 15 paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15, 23, and 27) that subscribe to the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a second database containing a plurality of digital contents which are subject to legal protection on behalf of content proprietors (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a *delivering* section that *delivers* the advertising messages over the computer network to the users via the plurality of user terminals (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8); *another delivering* section that *delivers* the registered digital content to another of user via the *second* user terminal *when receiving the* request from the another user over the computer network (page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraph 134, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietor of the registered digital content identified in the status information (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraph 142, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20); a *receiving* section that *receives* digital content from one of the users via *the first* user terminal wherein the users are different from the identified content proprietors (page 8

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paragraphs 138 and 139, page 11 paragraph 190, page 20 paragraph 343, and Figure 15).

*Yamanaka is silent about creating a secondary work by the one user, who is different from the identified content proprietor. ImgRadio teaches creating as a secondary work by the one user, who is different from the identified content proprietor (i.e. a user creates his own radio station by selecting songs by various artists and enables others to access his radio station) (page 1 paragraph 3, page 2 paragraphs 9-12 and 15). It would have been obvious to Yamanaka to include creating a secondary work by the one user, who is different from the identified content proprietor to enable users to share their favorite contents with their family members and thereby help promote referral business.*

*Yamanaka is also silent about the receiving section receiving a digital content from one of the users via the first user terminal together with status information indicating that received digital content is subject to the legal protection and identifying a content proprietor of the received digital content. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign. Furthermore, it's old and well known for users to include status information and content proprietor information as done by those users who may be providing free downloads*

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*from their websites for computer programs, to ensure that proper credit goes to the developer and owner of the program and not the distributor of the program and to protect the user from any liability associated with misrepresenting and marketing the content as being his own rather than belonging to the actual developer of the program.*

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner *and to ensure that the owner of the proprietary content receives credit for the content and not the distributor of the content.* Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor *for paid content* as indicated by the data presented from the execution key associated with a particular content holder for the number of times the content was executed by a user can be made quickly and accurately.

5. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital contents subject to legal protection (i.e. content owned by creators and holders excluding distributors that requires the use of an execution key) and non-protected digital contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23,

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27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are *delivered* to the users via the user terminals (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

6. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles by the same manufacturer of the game CD's, and multiple movies by the same movie director) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the digital contents is *delivered* to the users via the user terminals (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 7

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paragraph 131, page 8 paragraphs 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

7. In reference to claims 3, 7, 11, and 15, Yamanaka discloses a system, method, a machine readable medium, and computer-readable storage device wherein the allocating section allocates the collected advertisement fees only if registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) digital content is *delivered* under the legal protection (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal protection) indicating whether or not the contributed digital contents are subject to the legal protection.

Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner.



**Response to Arguments**

8. After careful review of Applicant's remarks/arguments filed on 04/27/2007, the Applicant's arguments with respect to claims 1-16 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection.

Amendments to the drawings and claims have been entered and considered.

9. Applicant argues that Yamanaka does not teach the holder or agent submit or receive a secondary work of the original work from other users via user terminals where secondary work is work created by another, with additional information added, from one of the users via a first user terminal. Additionally, Applicant claims that a receiving request is received from a second user terminal for the delivery of the content. As addressed above, applicant's amendment is addressed by the ImgRadio article, since the article teaches a user making his own radio station by selecting content of his choice, by giving the station a name, and by even posting reviews, and then sharing the content with other users who request the delivery of this content (page 1 paragraph 3 and page 2 paragraphs 9-15).

10. Applicant argues that the issue germane to patentability is not whether it would have been obvious for the user who has no affiliation with the creator to include legal notices or creator's information and contribute the contents, since there is no suggestion to do this in Yamanaka. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, obviousness is established by combining Yamanaka's teachings with the motivation found in the knowledge generally available to one of ordinary skill in the art.

Specifically, it would be obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner and to ensure that the owner of the proprietary content receives credit for the content and not the distributor of the content. Additionally, just because a user posts a music file online doesn't mean someone else can download it for free, since the first user may have paid royalties and the second would need to do so in order to have legal access to the file. Therefore, there would have been motivation by a third party or an agent to include a legal notice to prevent any legal consequences.

Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor for paid content as indicated by the data presented from the execution key associated with a particular content holder for the number of times the content was executed by a user can be made quickly and accurately. Therefore, motivation can indeed be found in the knowledge generally available to one of ordinary skill in the art.

10. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

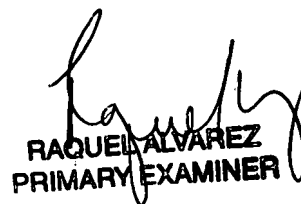
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



N.B.

June 28<sup>th</sup>, 2007



RAQUEL ALVAREZ  
PRIMARY EXAMINER